



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/779,669	02/18/2004	Wen-Ching Hou	3624-0156P	8540
2292	7590	01/31/2005	EXAMINER	
BIRCH STEWART KOLASCH & BIRCH PO BOX 747 FALLS CHURCH, VA 22040-0747			HUNTER, ALVIN A	
			ART UNIT	PAPER NUMBER
			3711	

DATE MAILED: 01/31/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

SN

Office Action Summary	Application No. 10/779,669	Applicant(s) HOU ET AL.	
	Examiner Alvin A. Hunter	Art Unit 3711	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 October 2004.
 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
 5) ☐ Claim(s) _____ is/are allowed.
 6) ☒ Claim(s) 1-4, 7, 10 and 13-19 is/are rejected.
 7) ☒ Claim(s) 5, 6, 8, 9, 11 and 12 is/are objected to.
 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
 * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Objections

Claims 5-8 are objected to because of the following informalities: the limitation "the perimeter wall" should read --the bent perimeter wall--. Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 7, 16, and 17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 7 recites the limitation "the recess" in line 3. There is insufficient antecedent basis for this limitation in the claim.

Claim 16 and 17 recites "Kevlar" which is a trademarked material. The use of the name makes the claim indefinite because applicant cannot control the content of the trademark material.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3, 10, 13-15, 18, and 19 are rejected under 35 U.S.C. 102(b) as being anticipated by Takeda (USPN 6030295).

Regarding claim 1, Takeda discloses a golf club having a body made of a first material and including a cavity **18** in a rear thereof, a striking plate **2** provided on a front side of the body, and a vibration-absorbing plate **17** made of a second material relatively lighter than the first material of the body and the vibration-absorbing plate fixed in the cavity of the body and spaced apart from the striking plate to define a hollow chamber therebetween that the hollow chamber prevents from obstructing deformations of the striking plate to permit deformation of the striking plate while striking a golf ball and the vibration-absorbing plate directly absorbs vibrations from the body, thereby the vibration-absorbing plate gaining a damping effect of the golf club head (See Figure 1).

Regarding claim 2, Takeda discloses the cavity of the body including a stepped portion for supporting and fixing the vibration-absorbing plate (See Figure 1).

Regarding claim 3, Takeda discloses the striking plate integrally formed with the body (See Figure 1).

Regarding claim 10, Takeda discloses the body having a compartment in a bottom thereof for receiving a weight member **26** (See Figure 4).

Regarding claim 13, Takeda discloses the vibration absorbing plate being a light metal plate or a light alloy plate (See Column 3, lines 23 through 45).

Regarding claim 14, Takeda discloses the light metal being titanium (See Column 3, lines 23 through 45).

Art Unit: 3711

Regarding claim 15, Takeda discloses the light alloy plate being an alloy of titanium (See Column 3, lines 23 through 45).

Regarding claim 18, Takeda discloses the golf club head being an iron club head (See Figure 1).

Regarding claim 19, Takeda discloses the hollow chamber being empty (See Figure 1).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Takeda (USPN 6030295) in view of OFFICIAL NOTICE.

Regarding claim 4, Applicant claims the body having a recess in a front side thereof and an aperture connecting the recess to the cavity wherein the recess includes a stepped portion for supporting the striking plate in the recess. Takeda discloses the striking face being integrally with the head body and made of the same material as the head body. One having ordinary skill in the art would draw therefrom that attaching the striking plate within the stepped portion of the recess would not change the performance of the invention. Alternatively, it is common within the art to use the above construction to connect the striking plate to the club head (See US Patents 5697855,

Art Unit: 3711

6045465, and 6086485). One having ordinary skill in the art would find it obvious to use such construction in order to join the striking plate to the head body.

Claims 16 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Takeda (USPN 6030295) in view of Kosmatka (USPN 6364789).

Regarding claims 16 and 17, Takeda discloses that the vibration-absorbing plate may be made of other materials, but does not explicitly disclose the use of Kevlar or graphite. Kosmatka discloses a golf club wherein an annular deflection enhancement member surrounds the striking face to reduce the deflection that occurs on the golf ball during impact (See Summary of the invention). The annular deflection enhancement member is made of titanium, Kevlar and/or graphite. One having ordinary skill in the art would draw from Kosmatka that the materials used for the annular deflection enhancement member absorb vibrations and, therefore, would have been obvious to use for such reasons (See Background of the invention and Summary of the Invention).

Allowable Subject Matter

Claims 5-9, 11, and 12 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claim 7 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Response to Arguments

Art Unit: 3711

Applicant's arguments with respect to claims 1-18 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alvin A. Hunter whose telephone number is (571) 272-4411. The examiner can normally be reached on Monday through Friday from 7:30AM to 4:00PM Eastern Time.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gregory Vidovich, can be reached on 571-272-4415. The fax phone

Art Unit: 3711

number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

AAH

Alvin A. Hunter, Jr.


Steven Wong
Primary Examiner